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10/057,046	01/25/2002	Katsumi Kanasaki	RCOH-1044	3429

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EXAMINER

SERRAO, RANODHI N

ART UNIT	PAPER NUMBER
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2141

MAIL DATE	DELIVERY MODE
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04/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/057,046

Applicant(s)

KANASAKI, KATSUMI

Examiner

RANODHI N. SERRAO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 February 2008 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant argued,

Although the applicant believes that the new address definition includes a new address, for the sake of advancing prosecution, the applicant has further elucidated the patentable feature of the current invention as the Examiner has implied.

4. The examiner points out that the specification does not support applicant's newly added and prior limitations. Particularly the limitation, automatically generating a new address definition including a new address, is not disclosed. Therefore the claims are rejected under 112, first paragraph as shown below. Furthermore, the applicant did not attempt to point out which sections of the specification relate to these limitations. For the purposes of examination, the limitations have been incorporated into the claims,

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however the limitation, "a new address" is interpreted as a new address definition.

Therefore the cited prior art teach these added features. The remainder of applicant's arguments is directed to the newly added limitations which have been addressed.

5. The examiner points out that the pending claims must be "given the broadest reasonable interpretation consistent with the specification" [In re Prater, 162 USPQ 541 (CCPA 1969)] and "consistent with the interpretation that those skilled in the art would reach" [In re Cortright, 49 USPQ2d 1464 (Fed. Cir. 1999)]. In conclusion, upon taking the broadest reasonable interpretation of the claims, the cited references teach all of the claimed limitations. And the rejections are maintained.

Specification

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The below mentioned limitations of claims 1, 12, 21, and 22 are not supported in the applicant's specification. See below rejection.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 12, 21, and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject

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matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant application's specification does not disclose the limitation of, automatically generating a new address definition including a new address. Neither can the examiner find nor has the applicant pointed out where this limitation is taught in the disclosure. There is no mention in the specification of automatically generating a new address definition much a new address definition that includes a new address. The only mention of automatically performing a step is in ¶ 2, however this does not relate to claimed limitations. Therefore the claims fail to comply with the written description requirement.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 1 recites, "a new address" multiple times in lines 7 and 8. Further in line 13, the claim recites, "the new address." It is vague and unclear which one of the new addresses "the new address" refers to. Furthermore the claim recites, **requesting** an address definition **from a second device** to a first device. Then recites, **returning** the address definition containing a plurality of components to the second device **from the first device**. Emphasis added. If an address definition is requested from a second

device, it should be returned from the second device not the first. The examiner fails to see how the address definition can be returned from the first device when the first device is requesting the address definition from the second device. This does not make logical sense. Therefore the claim is vague and indefinite.

12. Claims 21 and 22 recite similar language in regards to requesting an address definition. Therefore these claims are rejected as being indefinite.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claims 21-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. There is no mention in the applicant's specification what "a computer readable medium" consists of.

15. The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383

U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Claim Rejections - 35 USC § 103

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

17. Claims 1, 2, 12, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holleran et al. (5,752,059) and Taylor et al. (5,754,306).

18. As per claim 1, Holleran et al. teaches a method of flexibly managing addresses for a communication system (see Holleran et al., col. 3, lines 26-52), comprising the steps of: requesting an address definition from a second device to a first device; returning the address definition containing a plurality of components to the second device from the first device (see Holleran et al., col. 5, lines 40-64); obtaining a corresponding predetermined rule definition for the address definition to generate a new address (see Holleran et al., col. 8, lines 1-20); automatically generating a new address definition including a new address based upon the corresponding predetermined rule definition at the second device (see Holleran et al., col. 8, lines 46-65); and returning the newly generated address definition including the new address from the second address to the first device (see Holleran et al., col. 9, lines 13-23). But fails to teach generating a new address definition based upon the corresponding conditions at the second device, the newly generated address definition including some components based upon the

corresponding predetermined rule definition and the corresponding conditions.

However, Taylor et al. teaches automatically generating a new address definition based upon the corresponding predetermined rule definition and corresponding conditions at the second device (see Taylor et al., col. 23, line 52-col. 24, line 18), the newly generated address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions (see Taylor et al., col. 24, lines 19-40). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holleran et al. to automatically generating a new address definition based upon the corresponding predetermined rule definition and corresponding conditions at the second device, the newly generated address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions in order to provide an electronic address book which allows information to be efficiently sent to users of both electronic mail and facsimile transmission (see Taylor et al., col. 3, lines 11-24).

19. As per claim 2, the above-mentioned motivation of claim 1 applies fully in order to combine Holleran et al. and Taylor et al. Taylor et al. and Holleran et al. teach a method of flexibly managing addresses for a communication system, wherein the addresses include e-mail addresses, document folders, telephone number and fax numbers (see Taylor et al., column 10, lines 28-34).

20. As per claim 12, Holleran et al. teaches a system for flexibly managing addresses for a communication system, comprising: a third device sending a request for an address definition for use with a predetermined operation; a second device

connected to said third device for receiving the request for the address definition and sending the request for the address definition (see Holleran et al., col. 3, lines 26-52); and a first device connected to said second device for returning the address definition containing a plurality of components to said second device in response to the address definition request (see Holleran et al., col. 5, lines 40-64), said first device further including an address maintenance unit for maintaining address information (see Holleran et al., col. 4, line 55-col. 5, line 3); wherein said second device obtaining a corresponding predetermined rule definition for the address definition to generate a new address (see Holleran et al., col. 8, lines 1-20) and automatically generating a new address definition including the new address based upon the corresponding predetermined rule definition (see Holleran et al., col. 8, lines 46-65), said second device returning the newly generated address definition including the new address to said third device (see Holleran et al., col. 9, lines 13-23). But fails to teach wherein said second device obtaining predetermined conditions for the address definition to generate a new address, the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding conditions. However, Taylor et al. teaches wherein said second device obtaining predetermined conditions for the address definition to generate a new address (see Taylor et al., col. 23, line 52-col. 24, line 18), the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding conditions (see Taylor et al., col. 24, lines 19-40). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holleran et al. to

wherein said second device obtaining predetermined conditions for the address definition to generate a new address, the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding conditions in order to provide an electronic address book which allows information to be efficiently sent to users of both electronic mail and facsimile transmission (see Taylor et al., col. 3, lines 11-24).

21. As per claim 22, Holleran et al. teaches a computer readable medium storing computer executable instructions for performing the task of flexibly managing addresses for a communication system, the computer executable instructions comprising the steps of: requesting an address definition from a second device to a first device; returning the address definition containing a plurality of components to the second device from the first device (see Holleran et al., col. 5, lines 40-64); obtaining a corresponding predetermined rule definition for the address definition to generate a new address (see Holleran et al., col. 8, lines 1-20); automatically generating a new address definition including the new address based upon the corresponding predetermined rule definition at the second device (see Holleran et al., col. 8, lines 46-65). But fails to teach obtaining a corresponding condition for the address definition to generate a new address, the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding condition; returning the newly generated address definition including the new address from the second device to the first device, the address definition each has a unique ID; determining whether or not an ID already exists; storing the newly generated address if the ID does not exist; and

replacing information with the newly generated address if the ID exists. However, Taylor et al. teaches obtaining a corresponding predetermined rule definition and a corresponding condition for the address definition to generate a new address (see Taylor et al., col. 23, line 52-col. 24, line 18), the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding condition (see Taylor et al., col. 24, lines 19-40); returning the newly generated address definition including the new address from the second device to the first device, the address definition each has a unique ID; determining whether or not an ID already exists; storing the newly generated address if the ID does not exist; and replacing information with the newly generated address if the ID exists (see Taylor et al., col. 29, lines 18-30). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holleran et al. to obtaining a corresponding predetermined rule definition and a corresponding condition for the address definition to generate a new address, the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding condition; returning the newly generated address definition including the new address from the second device to the first device, the address definition each has a unique ID; determining whether or not an ID already exists; storing the newly generated address if the ID does not exist; and replacing information with the newly generated address if the ID exists in order to provide an electronic address book which allows information to be efficiently sent to users of both electronic mail and facsimile transmission (see Taylor et al., col. 3, lines 11-24).

22. Claims 3, 4, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holleran et al. and Taylor et al. as applied to claim 1 above, and further in view of Krishnaswamy et al. (5,999,525).

23. As per claim 3, Holleran et al. and Taylor et al. teach the mentioned limitations of claim 1 above but fail to teach wherein the first device is an existing user account management unit for user account information. However, Krishnaswamy et al. teaches wherein the first device is an existing user account management unit for user account information (see Krishnaswamy et al., column 23, lines 37-47). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Taylor et al. and Holleran et al. to wherein the first device is an existing user account management unit for user account information in order to attach individual systems for billing, provisioning, directory services, messaging services such as voice messaging via a communication link (see Krishnaswamy et al., col. 23, lines 23-36).

24. As per claims 4, 10, and 11, the above-mentioned motivation of claim 3 applies fully in order to combine Holleran et al., Taylor et al, and Krishnaswamy et al.

25. As per claim 4, Holleran et al., Taylor et al., and Krishnaswamy et al. teach an address maintenance unit that corresponds to the existing user account management unit for managing address information (see Krishnaswamy et al., column 23, lines 37-47).

26. As per claim 10, Holleran et al., Taylor et al., and Krishnaswamy et al. teach wherein said generating the new address definition is performed prior to said requesting the address definition (see Krishnaswamy et al., column 108, lines 21-32).

27. As per claim 11, Holleran et al., Taylor et al., and Krishnaswamy et al. teach wherein the address definition each has a unique ID and further comprises additional steps of determining whether or not an ID already exists; storing the newly generated address if the ID does not exist; and replacing information with the newly generated address if the ID exists (see Krishnaswamy et al., column 102, lines 50-67).

28. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnaswamy et al., Taylor et al., and Holleran et al. as applied to claims 1 and 4 above, and further in view of Ouchi (5,978,836).

29. As per claim 5, Krishnaswamy et al., Taylor et al., and Holleran et al. teach the limitations of claims 1 and 4 as described above but fail to teach wherein the address maintenance unit manages delivery methods by adding a new delivery method. Ouchi however teaches wherein the address maintenance unit manages delivery methods by adding a new delivery method (column 12, lines 46-65). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit manages delivery methods by adding a new delivery method in order to go off route and capture the optimal route of transmission.

30. As per claim 6, Krishnaswamy et al., Taylor et al., and Holleran et al. teach the limitations of claims 1, 4, and 5 as described above but fail to teach wherein the new delivery method is specified in the rule definition. Ouchi however teaches wherein the new delivery method is specified in the rule definition (column 8, lines 13-31). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the new delivery method is specified in the rule definition in order to insure that the value for the active document is unique.

31. As per claim 7, Ouchi, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1, 4, 5, and 6 as described above but Ouchi, Taylor et al., and Holleran et al. fail to teach wherein the rule definition further includes or the address maintenance unit additionally manages an ID value, a Source value, a Condition value, a Name Generation Method value, and a Type Generation Method value.

Krishnaswamy et al., however teaches wherein the rule definition further includes or the address maintenance unit additionally manages an ID value, a Source value, a Condition value, a Name Generation Method value, and a Type Generation Method value (column 99, line 58-column 101, line 16: wherein VNET numbers serve the function of a Condition value, unique ID serves the function of an ID value, IP address serves the function of a Source value, a Name Generation Method value, and a Type Generation Method value). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the rule definition further includes or the address maintenance unit additionally manages an ID value, a Source value, a Condition value, a Name Generation Method value, and a

Type Generation Method value in order to allow an user to register his/her computer as "on-line" and available to receive calls.

32. As per claim 8, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1 and 4 as described above but fail to teach wherein the address maintenance unit manages delivery methods by deleting an existing delivery method. Ouchi however teaches wherein the address maintenance unit manages delivery methods by deleting an existing delivery method (column 6, line 48-column 7, line 7). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit manages delivery methods by deleting an existing delivery method in order to permit more than one concurrent use of a workflow route.

33. As per claim 9, Ouchi, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1 and 4, as described above but Ouchi, Taylor et al., and Holleran et al. fail to teach wherein the address maintenance unit updates the address information based upon the user account information. Krishnaswamy et al. however teaches wherein the address maintenance unit updates the address information based upon the user account information (column 41, lines 27-35). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit updates the address information based upon the user account information because cache copies must be refreshed when the version is out of date.

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34. Claims 13-21 have similar limitations as to claims 1-12 and 22 above; therefore, they are being rejected under the same rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ranodhi Serrao whose telephone number is (571)272-7967. The examiner can normally be reached on 8:00-4:30pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571)272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/R. N. S./

Examiner, Art Unit 2141

3/21/2008

/William C. Vaughn, Jr./

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Supervisory Patent Examiner, Art Unit 2144